

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No.: 10/591,122

Attorney Docket No.: Q81160

REMARKS

Claims 1-32 are all the claims pending in the application, prior to the filing of this Amendment.

Applicants have canceled claims 1 to 22, and have amended claim 23 to incorporate the recitations of claim 24. Applicants have canceled claim 24.

Thus, all the claims that remain in the application are directed to a sliding member composition or a sliding member, or a method for producing a sliding member composition or a sliding member.

The Examiner has set forth 13 separate rejections of the claims over various documents. Applicants discuss each of the rejections below.

The first ten of these rejections are rejections of the claims on the basis of non-statutory obviousness type double patenting.

Applicants set forth these ten rejections as follows.

- 1) Claims 1-32 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent 7,390,593 to Yamamoto et al.
- 2) Claims 1-32 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent 7,150,840 to Yamamoto et al.
- 3) Claims 1-32 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent 7,122,132 to Morita et al.
- 4) Claims 1-32 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent 6,844,061 to Morita et al.
- 5) Claims 1-32 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent 6,974,627 to Morita et al.

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6) Claims 1-32 have been provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Appln. No. 11/662,645 to Nagao et al.

7) Claims 1-32 have been provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Appln. 10/592,121 to Nagao et al.

8) Claims 1-32 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Appln. No. 10/570,140 to Nagao et al.

9) Claims 1-32 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Appln. No. 11/661,130 to Nagao et al.

10) Claims 1-32 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Appln. No. 10/540,560.

None of the above ten cited documents describes a sliding member composition or a sliding member, or a method for producing a sliding member composition or a sliding member. Accordingly, applicants submit that the present invention as defined in claims 23 and 25 to 32 is not obvious from the above ten cited documents and, accordingly, request withdrawal of the above ten rejections.

Applicants now discuss the eleventh to thirteenth rejections.

11) Claims 1-6, 9-16, 23-26, 31 and 32 have been rejected under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over WO 03/027368 to Morita et al.

Applicants note that the WO '368 document to Morita et al corresponds to U.S. Patent 6,974,627 to Morita et al that is employed by the Examiner in rejection 5) above.

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Applicants submit that WO 03/027368 does not disclose or render obvious the subject matter of claims 23 and 25 to 32 and, accordingly, request withdrawal of this rejection.

WO 03/027368 discloses a composition comprising a resin and a fine carbon fiber mixture containing fine carbon fiber and non-fibrous carbon, such as flake-like carbon, granular carbon or sheet-like carbon, which is useful as a filler material employed in an electric sliding material.

Meanwhile, the sliding member composition and sliding member of the present invention comprise a specific vapor grown carbon fiber and resin. The vapor grown carbon fiber employed in the present invention is different from the mixture of fine carbon fiber and non-fibrous carbon disclosed in WO 03/027368. Therefore, the present invention is not the same as that of WO 03/027368.

Further, WO 03/027368 only describes the friction coefficient of the fine carbon fiber. Meanwhile, the present invention provides a sliding member composition which exhibits a heat deflection temperature of 160°C or higher with high thermal conductivity, and a method for producing a sliding member composition comprising kneading a thermoplastic resin and a vapor grown carbon fiber, wherein the kneading is performed without applying strong shear force, so as to suppress the breakage rate of the carbon fiber to 20% or less. Such a method is not disclosed or suggested by WO 03/027368.

Accordingly, the teachings of WO 03/027368 do not anticipate the subject matter of the present invention and would not have rendered obvious the subject matter of the present invention.

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The thermal conductivity of the composition according to WO 03/027368, which comprises amorphous carbon (having a low crystallinity) and a granular carbon (having low aspect ratio), is generally inferior to that of the composition comprising a fibrous filler (having high aspect ratio) only.

In view of the above, applicants submit that WO 03/027368 does not disclose or render obvious the subject matter of claims 23 and 25 to 32 and, accordingly, request withdrawal of this rejection.

12) Claim 7 has been rejected under 35 U.S.C. § 103(a) as obvious over WO '368 to Morita et al.

As discussed above, claim 7 has been canceled. Accordingly, this rejection is moot.

13) Claims 1-32 have been rejected under 35 U.S.C. § 103(a) as obvious over WO 03/027368 to Morita et al and further in view of U.S. Patent 6,528,572 to Patel et al.

Applicants submit that WO 03/027368 and Patel do not disclose or render obvious the subject matter of claims 23 and 25 to 32 and, accordingly, request withdrawal of this rejection.

WO 03/027368 has been discussed in detail above in rejection 11) and applicants rely on that discussion.

Applicants submit that Patel et al do not supply the above deficiencies of WO 03/027368.

Patel et al only disclose a method for kneading a resin and a conductive filler, but do not describe or suggest the kneading method of the present invention as mentioned above. Further, Patel et al do not describe a sliding member. Therefore, applicants submit that the combination of WO 03/027368 and Patel et al would not have rendered obvious the subject matter of the present claims.

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In view of the above, applicants submit that WO 03/027368 and Patel do not disclose or render obvious the subject matter of claims 23 and 25 to 32 and, accordingly, request withdrawal of this rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

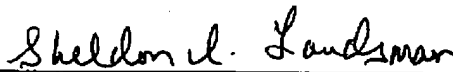
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